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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,304	01/06/2000	GEOFFREY B. RHOADS	60085	2884

23735 7590 02/03/2006

DIGIMARC CORPORATION  
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BEAVERTON, OR 97008

EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/479,304	Applicant(s) RHOADS, GEOFFREY B.	
	Examiner Ponnoreay Pich	Art Unit 2135	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, ~~the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-10.  
Claim(s) withdrawn from consideration: 11-15.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

***Response to Arguments***

Applicant's arguments filed 1/23/2006 have been fully considered but they are not persuasive.

Applicant's election with traverse of the invention of Group I (claims 1-10) in the reply filed on 1/23/2006 is acknowledged. The traversal is on the ground(s) that the Office has failed to meet its prima facie burden of showing that the respective set of claims are both independent and distinct. Applicant also does not believe that maintaining all claims in a single application would be unduly burdensome on the Office. This is not found persuasive because the examiner set forth reasons in the final office actions why the groups of claims are independent and distinct. Applicant has not pointed out any errors on the part of the examiner in stating that the inventions are independent and distinct except to say that an error does exist. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). As far as burden of search is concerned, the examiner respectfully submits that it would indeed be a burden upon the office to search each subcombinations represented by each group of inventions as applicant had submitted. The invention of Group I (claims 1-10) is clearly drawn to using steganography to determine use of a cell phone and prevent fraud. The invention of Group II (claims 11-12) is drawn to conveying information via band frequencies of *any* type of wireless transmission. The invention of Group III (claims 13-14) is drawn to using steganography to improve encoding in *any* wireless devices. The invention of Group IV is drawn to using decoded

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steganographic data to control the operation of *any* wireless device which receives a wireless signal. The manner in which the examiner approaches formulating a search for a group of claims is to first determine the type of systems and the specific uses that the group of claims can be applied. The invention of Group I clearly applies to just a cell phone system. The other three groups of claims can be applied to other types of wireless systems beyond just cell phone systems. Had the examiner examined Groups II-IV also, the examiner would have had to extend the search into several different areas of wireless systems beyond just cell phone systems and the examiner would have had to consider all other types of wireless systems that Groups II-IV could have been used to perform a proper search. The examiner would not have had to do this for a search of Group I alone and the searches for Groups II-IV would probably have focused more on computer networks and wireless computer networks rather than cell phones. Even among Groups II-IV, there would have been differing search strategies used for one group and not for another as well as searches in classes/subclasses for one group and not for another since the claims of Groups II-IV were directed towards differing use of a wireless network. Further, while the searches of the groups may overlap to some extent, there is no reason to believe that the searches would be coextensive. The requirement is still deemed proper and is therefore made FINAL. Claims 11-15 are removed from further consideration as being drawn to non-elected inventions.

Applicant still argues that the Office has failed to establish a prima facie unpatentability of the claims and states that only with benefit of hindsight, provided by applicant's specification, would one of ordinary skill combine Ariyavisitakul and

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Hembrook in the various manners asserted in the Action. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner respectfully submits that applicant has not pointed out any specific errors in the examiner's rejection in combining Ariyavisitakul and Hembrook's teachings to reject the claims except to say that it is hindsight reasoning. The teachings of the references clearly showed that the limitations recited in the references were within the knowledge of one of ordinary skill in the art at the time applicant's invention was made and taught by the prior art. Further, the examiner gave a motivation why one of ordinary skill in the art would have had to combine the two teachings, which would render the limitations recited in the claims obvious and unpatentable. The motivation the examiner gave came one of the three possible sources to combine references as set for in MPEP 2143.01: The nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art", see *in re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The motivation that the examiner gave to combine the two teachings was that Hembrooke's teachings would allow for the identification of a signal's origin. The examiner explained in the last office action that cell phone fraud was a

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known problem in the art at the time applicant's invention was made. Applicant even admitted that one of the prior art solution was to monitor a cell phone's RF signal to identify the origination phone. The incorporation of Hembrooke's teachings within Ariyavisitakul's cell phone system allows for the identification of a signal's (i.e. cell phone signal's) origin, thus is a motivation that applicant admits was within knowledge of one of ordinary skill in the art at the time applicant's invention was made. The teachings in the prior art of cell phones as admitted by applicant teaches that one of ordinary skill would have been motivated to prevent cell phone fraud. Not only was this disclosed in applicant's specification, but also in the numerous documents submitted in applicant's IDS submitted on 9/16/2005. Clearly this motivation is not taken from applicant's specification alone.

Applicant argues that the Office overreaches when it asserts that the two references are properly combinable because they both "belong to the broad class of signal processing". The examiner respectfully disagrees. Ariyavistakul teaches about cell phone systems, which draws from the teachings of signal processing. Further, Hembrooke discloses that his invention is related to the identification of sounds and like signals, which is a type of signal processing. Hembrooke also discloses that his teachings can be used for the identification of signals of any kind (col 1, lines 34-38). From this statement, the examiner respectfully submits that Hembrooke is stating that his teachings would be applicable to more than just the examples he specifically disclosed in his patent and would be applicable to other problems in signal processing. Hembrooke is silent as far as what limit his teachings would apply as long as they are

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used for the identification of any signal of any kind (col 1, lines 34-38), thus the examiner submits that it is not unreasonable for one of ordinary skill to apply Hembrooke's teachings to any class or subclass in signal processing, including the cell phone art. Applicant's statement that the field is too enormous to serve as a predicate for combination and that such overreaching will not be sustained by the Board appears to be applicant's opinion and applicant has not set forth any reasonable evidence to back up this statement.

Finally, applicant solicited clarification as to why the Office mentioned newly cited art in the specification at page 2, lines 13-14 and asks if such art forms any basis for the rejections. The examiner did not use the newly cited art as the basis for any particular rejections per se. Rather, the examiner mentioned those arts as evidence that preventing cell phone fraud and identifying signal origins were motivations that existed and were well known in the art at the time applicant's invention was made. This was in response to applicant's prior argument that the Office's position was tainted by hindsight, which the examiner assumed applicant meant that the motivation given to combine the references was improper. To reiterate, the newly cited art were not mentioned as the basis of any new rejections, but were merely cited as evidence in response to applicant's previous arguments.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

Ponnoreay Pich  
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